

## REMARKS

### Claim Status

Claims 1-39 and 41-59 are pending in the present application. Claims 1 and 17 are amended without prejudice and without conceding the merits of the 35 U.S.C. § 112, first paragraph, rejections.

### Art-based Rejections:

Claims 1-5, 7-17, 49 and 58-59 are rejected as being anticipated by U.S. Patent No. 6,836,844 (“Kori 844”). Claims 18-28, 32-33, 36-38 and 50-53 are rejected as being anticipated<sup>1</sup> under §102(e) over 6,687,802 (“Kori 802”). Claim 39, 41-48 and 54-57 are rejected as being unpatentable over Kori 844 in view of US 2001-0044899 A1 (“Levy”). Claims 29-31 are rejected as being unpatentable over Kori 802 in view of US 2001-0004203 A1 (“Shear”). Claims 34-35 are rejected as being unpatentable over Kori 802 in view of Ton Kalker’s “System image....” (“Kalker”).

We respectfully traverse these rejections.

#### *Claim 18 in view of Kori 802*

It is well settled that in order for an Examiner to establish a *prima facie* case of anticipation, each and every element of the claimed invention, arranged as required by the claim, must be found in a single prior art reference, either expressly or under the principles of inherency. *See In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677-78 (Fed. Cir. 1988); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

The previous final Office Action fails to establish such a *prima facie* case of anticipation .

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<sup>1</sup> The Office Action uses the term “unpatentable”. Although this term is usually used in an §103 rejection, we believe the Examiner intended to give an “anticipation” rejection under §102 since the Examiner references 35 U.S.C. §102(e). See the Office Action, page 10, paragraph 5.

For example, claim 18 recites – in combination with other features – analyzing first media content buffered in the output buffer; analyzing second media content buffered in the input buffer. Claim 18 further recites comparing the first media content buffered in the output buffer with the second media content buffered in the input buffer, wherein a copy operation is modified or disabled when the first media content and the second media content match or otherwise coincide.

The Office Action cites Kori 802 at Fig. 12 (and related text) to meet the features of claim 18. See the Office Action at page 11. In particular, the Office Action cites Kori's Col. 32, lines 8-14 for the recited comparing features. This passage is reproduced below for the Examiner's convenience.

*The control section 520 compares the contents ID from the contents ID detection section 512 with the contents IDs stored in the copying history information management memory 522 to search for the contents ID same as the contents ID of the audio signal instructed to be copied by the user (step S306).*

But this passage says nothing about comparing first media content *buffered* in an output buffer with second media content *buffered* in an input buffer. Thus, Kori 802 fails to establish a *prima facie* case of obviousness since it lacks each and every element of claim 18 arranged as claimed.

Claim 18 should be allowed over Kori 802.

*Claim 33 in view of Kori 802*

Claim 33 recites – in combination with other features – comparing first media content buffered in an output buffer to second media content buffered in an input buffer through correlation of the first media content with the second media content.

The Office Action cites Kori 802 at Fig. 12 (and related text) to meet the features of claim 12. See the Office Action at pages 14-15. In particular, the Office Action cites Kori's Col. 32, lines 8-14 for these comparing features (*quoted directly above*).

But this passage says nothing about comparing first media content *buffered* in an output buffer with second media content *buffered* in an input buffer. Thus, Kori 802 fails

to establish a *prima facie* case of obviousness since it lacks each and every element of claim 33 arranged as claimed.

Claim 33 should be allowed over Kori 802.

*Claim 39 in view of Kori 844 and Levy*

Claim 39 recites – in combination with other features – determining which out of a plurality of copy control systems applies to protected media content, said protected media content comprises a digital watermark embedded in the media content according to an embedding key, said determining determines which out of a plurality of copy control systems applies to the protected media content based on the embedding key; and controlling with at least a configured multi-purpose electronic processor the protected media content according to a determined copy control system.

The Office Action relies on Levy at paragraph [0022] for determining which out of a plurality of copy control systems applies to the protected media content based on the embedding key. See the previous final Office Action, page 17, last paragraph.

The cited Levy passage is provided below.

*[0022] The transmarking process illustrated in FIG. 1 begins by detecting a first watermark in the watermarked signal (22). A watermark detector employs a watermark key to identify the presence of a watermark. The specific operation of the detector depends on the watermarking process employed. In many techniques, the watermark key specifies the spatial, time, and/or frequency domain location of the watermark signal. It may also specify how to decode a message that has been modulated with a pseudorandom number (e.g., frequency or phase hopping, spread spectrum modulation). To simplify the search for the watermark, the watermark detector searches for reference signal attributes of the embedded signal, such as a known sequence of embedded symbols, or a known signal pattern in a particular time, space, or transform domain. These attributes enable the detector to determine whether a watermark is present in a suspect signal, and to determine its position within the time, space and/or transform domain.*

As one of ordinary skill in the art will appreciate, this passage says nothing of determining which out of a plurality of copy control systems applies based on the embedding key.

Thus, the final Office Action overstates the significance of Levy. We respectfully submit that the cited passages do not render obvious the features of claim 39 including determining which out of a plurality of copy control systems applies to the protected media content based on a watermark embedding key.

Claim 39 should be allowed over Kori 844 and Levy.

*Claim 48 in view of Kori 844 and Levy*

Claim 48 recites – in combination with other features – a digital watermark embedded therein according to a watermark key, said digital watermark comprising a payload *which is separate from the watermark key*. The method includes determining which out of a plurality of copy control states should govern the protected media content by reference to the watermark key, and determining which out of a plurality of copy control systems the media content should be handled by reference to the watermark payload.

So a copy control state is determined by reference to a *watermark key*, and a copy control system is determined with reference to the *watermark payload*.

The Office Action cites to the same Levy paragraph [0022] as discussed above. As one of ordinary skill will see, there is no mention of copy control systems in the cited paragraph. Moreover, there is no discussion of determining a copy control state with reference to the watermark key, and a copy control system with reference to a watermark payload.

Claim 48 should be allowed over Kori 844 and Levy.

*Claims 1 and 17 in view of Kori 844*

Claims 1 and 17 variously recite – in combination with other features – if a content identifier is found in a data repository, modifying or disabling a copy function.

The cited Kori 844 passage (Col. 11) first determines a remaining copy permitted count before invoking a copy function. See Kori 844, Col. 11, lines 21-28. In contrast, claim 1 (and 17) recites, if the identifier is found in the data repository, modifying or

disabling a copy function, *such modifying or disabling being triggered through the presence of the identifier in the data repository.*

Claims 1 and 17 should be allowed over Kori 844.

*Remaining claims*

The Examiner is respectfully invited to reconsider the remaining claims as well.

Conclusion

We look forward to our upcoming interview. In the meantime, the Examiner is invited to telephone the undersigned at 503-469-4685 with any questions.

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Respectfully submitted,

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